

Application No.: 10/849,574  
Amdt dated: December 4, 2008  
Reply to Office action of September 5, 2008

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action of September 5, 2008. Claims 1-16 were before the Examiner for consideration. In this paper, Claims 1, 3, and 9 have been amended, Claim 8 has been canceled, and no claims have been added. Accordingly, Claims 1-7 and 9-16 are now before the Examiner for consideration. No new matter has been added with these amendments.

#### **Summary of the Office Action**

In the Office Action, Claim 3 was rejected under 35 U.S.C. §112. Claims 1-5 and 8-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Carlson et al. (U.S. Patent No. 5,820,600). Claims 6 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlson. Claims 12-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Carlson in view of Smith (U.S. Patent No. 7,025,747). For at least the reasons discussed below, Applicant respectfully traverses these rejections.

#### **Regarding the Rejection under 35 U.S.C. §112**

Claim 3 was rejected under 35 U.S.C. §112 as being indefinite for failing to provide antecedent basis for the limitation "the carrier plate." Claim 3 has been amended to clarify the subject matter claimed therein by reciting "the base." Accordingly, this rejection is no longer applicable to Claim 3. Applicant therefore requests that this rejection be withdrawn.

**Carlson Fails to Disclose or Suggest All of the Recitations of Claim 1.**

As noted above, Claims 1-5 and 8-11 were rejected as being anticipated by Carlson, and Claims 6 and 7 were rejected as being unpatentable over Carlson. Claim 1 relates to a seal for a laparoscopic port comprising, among other limitations, a multiplicity of jaws, an actuator rotatable to urge the jaws to move between an open position and a closed position, and a diaphragm. Claim 1 further recites, among other limitations, that the diaphragm "includes a lip," and each jaw includes "a radially outward facing portion adapted to engage the lip so that the aperture of the diaphragm is forced to open as the jaws move to an open position." However, Carlson fails to disclose or suggest all of the recitations of Claim 1, from which Claims 2-11 depend.

Carlson describes an adjustable introducer valve having two valve members and a flexible membrane. (Carlson, col. 5, lines 61-63). The membrane includes an outer edge coupled with one of the valve members. (Carlson, col. 8, lines 29-34). Axial movement of the two valve members relative to each other cause this membrane to stretch or relax thereby changing the area of an aperture formed therein. (Carlson, col. 8, lines 34-49, Figures 2, 3). Carlson also describes holding members for securing an instrument at or near the center of the membrane. (Carlson, col. 9, lines 63-66, Figures 5A, 5B). Carlson indicates that the holding members "may be actuated by movement of ring 50 so that the size of central opening 116 [defined between inner ends of the

holding members] corresponds to the size of aperture 62." (Carlson, col. 10, lines 15-18).

Carlson fails to disclose or suggest that these holding members (indicated in the Office Action to correspond to the jaws recited in the present application) include features "adapted to engage" the membrane, as is recited in Claim 1. Rather, Carlson discloses only that the holding members have inner ends with an "arcuate shape that is complementary to the outer surface of an instrument shaft." (Carlson, col. 10, lines 1-3). Further, Carlson fails to disclose or suggest an engagement between the membrane and the holding members such that an aperture in the membrane is "forced to open" as the holding members move to an open position, as is recited with respect to the device of Claim 1. Rather, the device described by Carlson includes an edge on the membrane that is retained by one of two valve members. Relative movement of the two valve members—movement of the ring 50 relative to the tower 40—causes the membrane to stretch or relax, changing the area of aperture therein. (Carlson, col. 8, lines 30-49). In one alternative embodiment, movement of the ring 50 can actuate the holding members. (Carlson, col. 10, lines 15-19). However, even in this alternative embodiment, the holding members do not engage the membrane. Therefore movement of the holding members to an open position does not open the aperture in the membrane.

Accordingly, for at least the reasons discussed above, Claim 1 is distinguishable over Carlson. Claims 2-5 and 9-11 depend from Claim 1 and recite additional novel

Application No : 10/849,574  
Amdt dated: December 4, 2008  
Reply to Office action of September 5, 2008

and nonobvious limitations thereon. Claim 8 has been canceled herein. Accordingly, Claims 2-5 and 9-11 are distinguishable over Carlson for at least the reasons discussed above with respect to Claim 1.

Claims 6 and 7 likewise depend from Claim 1 and recite additional novel and nonobvious limitations thereon. As discussed above, Carlson fails to disclose or suggest all of the recitations of Claim 1. Moreover, Carlson teaches away from the seal of Claim 1: Carlson emphasizes that "first and second valve members are movable relative to each other to change the shape of the membrane" and "the valve members are configured to symmetrically stretch the outer edge of the membrane so the central aperture substantially maintains a circular shape in the enlarged configurations, which minimizes fluid leakage through the membrane." (Carlson, col. 5, lines 63-67, col. 6, lines 18- 22). If the device were modified, against the express teaching of Carlson, such that the holding members, rather than relative movement of valve members, stretch the membrane, the three holding members illustrated in Figures 5A and 5B would not maintain the circular shape of the aperture in the membrane in an enlarged configuration. Carlson indicates that such a non-circularity leads to leakage. Accordingly, one of skill in the art would be dissuaded by Carlson from modifying the Carlson device to achieve the device recited in Claim 1. Accordingly, for at least the reasons discussed above, Claims 6 and 7, which depend from Claim 1 are distinguishable over Carlson.

Application No : 10/849,574  
Amdt dated: December 4, 2008  
Reply to Office action of September 5, 2008

**The Asserted Combination of Carlson with Smith Fails to Disclose or Suggest the Claimed Device.**

As noted above, Claims 12-16 were rejected as being unpatentable over Carlson in view of Smith. Claims 12-16 depend from Claim 1 and recite additional novel and nonobvious limitations thereon. For at least the reasons discussed above, Carlson fails to disclose or suggest all of the recitations of Claim 1.

Smith likewise fails to disclose or suggest the deficiencies of Carlson with respect to Claim 1. For example, Smith describes a valve assembly having a diameter reduction structure. The diameter reduction structure includes an assembly of three stand offs 950 and three linking members 971. (Smith, col. 13, lines 27-36). The diameter reduction structure also includes an annular bias member 969 to bias standoffs 950 in a particular direction. (Smith, col. 13, lines 45-54). The Smith valve assembly also includes a first seal 825 positioned proximal to the diameter reduction structure. (Smith, col. 13, lines 24-26, Figure 18B). In other valves described in the Smith reference, a first seal is positioned distal to the diameter reduction structure (Smith, col. 11, lines 41-43, Figure 15, element 125). However, in both of these configurations, Smith fails to disclose or suggest that the stand offs include features "adapted to engage" the membrane, as is recited in Claim 1. Rather, in the Smith devices, the seals and diameter reduction structure do not engage one another.

Accordingly, for at least the reasons discussed above, the asserted combination of references fails to disclose or suggest all of the recitations of Claim 1, from which

Application No.: 10/849,574  
Amdt dated: December 4, 2008  
Reply to Office action of September 5, 2008

Claims 12-16 depend. Thus, for at least the reasons that Claim 1 is distinguishable over the applied art, Claims 12-16 are likewise distinguishable over the applied art.

### **Conclusion**

For at least the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowability is most earnestly solicited.

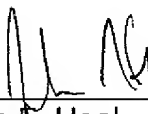
Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments have been made, no acquiescence or estoppel is or should be implied thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

Application No.: 10/849,574  
Amdt dated: December 4, 2008  
Reply to Office action of September 5, 2008

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, John F. Heal, at (949) 713-8283 to resolve such issues promptly.

Sincerely

APPLIED MEDICAL RESOURCES

BY   
\_\_\_\_\_  
John F. Heal  
Reg. No. 53,008  
Tel: (949) 713-8283